



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,043	08/02/2001	Takayuki Doki	TMI-103	7787

24956 7590 07/12/2005

MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.
1800 DIAGONAL ROAD
SUITE 370
ALEXANDRIA, VA 22314

EXAMINER

HEWITT II, CALVIN L

ART UNIT PAPER NUMBER

3621

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/857,043

Applicant(s)

DOKI, TAKAYUKI

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-36 is/are pending in the application.
- 4a) Of the above claim(s) 34-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-33 is/are rejected.
- 7) ☒ Claim(s) 34-36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5-25-05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Status of Claims

1. Claims 20-36 have been examined.

Claim Objections

2. Claims 34-36 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only and/or cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, claims 34-36 have not been further treated on the merits.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 20-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claim 20 recites "an ID number" (line 5), and "ID numbers transmitted

from a settlement management device" (lines 9 and 10) where the settlement management device receives an ID number from a settlement terminal device (lines 20 and 21). Subsequent lines and claims recite "said" and "the" ID number, therefore it is not clear to one of ordinary skill which ID number(s) is being referenced in the lines and claims.

Claims 21-36 are also rejected as they depend from claim 20.

b. Claim 20 is dedicated to a provision of services "based on an amount of money paid in advance by a user" (Preamble, claim 1). However, the third paragraph details a payment action after it has been determined that services can be provided, therefore the claim, specifically the scope is not clear ("... during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous" (*In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Claims 21-36 are also rejected as they depend from claim 20.

c. Applicant's system, as defined by claim 20, comprises a settlement terminal device configured to transmit balance information equivalent to an amount of money paid where an amount money, equal to a service amount, is subtracted from the balance information after it is been determined that a service can be provided. However, one of ordinary skill does not see how this can be

done as "the balance of information equivalent to an amount of money paid" is not actual money but mere bits of data.

Claims 21-36 are also rejected as they depend from claim 20.

d. The settlement management device of claim 22 validates an ID number when balance and ID information is transmitted from a terminal to the management device. Therefore, it is not clear to one of ordinary skill the step of a query for validation from an authentication device when the ID number has already been validated.

e. Claim 25 recites the limitation "the current balance" in line 4. Claim 28 recites the limitation "the current balance" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claims.

f. Claim 32 recites the limitation "said media units" in line 2. There is insufficient antecedent basis for this limitation in the claim.

g. Claim 33 recites the limitation "the new balance information" in line 6. There is insufficient antecedent basis for this limitation in the claim.

h. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: transmitting balance and ID information from the terminal device to the settlement management device.

Claims 21-36 are also rejected as they depend from claim 20.

i. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 20-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stimson et al., U.S. Patent No. 5,511,114 in view of Reese, U.S. Patent No. 4,969,183 and Walker, U.S. Patent No. 5,825,863.

As per claims 20-33, Stimson et al. teach a settlement system comprising:

- a settlement terminal device configured to read, at the time of settlement of media, an ID number (sub-ID number), unique to each media, and balance information and to transmit the ID number and balance information to a management device (figure 1; column 4, lines 17-43)
- a settlement device that can transmit deposit information (figures 1-3)
- a management device for validating the ID number (column 5, lines 29-31) and transmitting data to one of a plurality authentication devices based on

service specification information (i.e. phone number called) transmitted from the terminal device (column 5, lines 30-35)

- transmitting data from a service selection device to one of a plurality of authentication devices based on service information transmitted from the terminal device (i.e. number called) (column 5, lines 30-35)

However, Stimson et al. do not specifically recite an authentication device determining whether a service can be provided. Reese teaches an authentication device that receives an ID number and balance information (e.g. deposit information) and determines whether a service can be provided (figures 1A-2) and processes a payment received from a customer for providing said service (column 4, lines 3-23; column 5, lines 3-18). Further, the authentication device of Reese also stores customer specific information such as ID numbers (e.g. sub-ID numbers) that are associated with a customer's balance information (column 3, lines 8-12), queries a settlement management device in order to validate an ID, (column 4, lines 3-23) and prohibits service if the ID number is not validated or the amount is smaller than a current balance (column 4, lines 3-23). Stimson et al. teach a system that allows a customer to pay for a call using a calling card (abstract) while Reese provides customers with a phone service such as telephone lotto (abstract). Specifically, Reese allows users to pay for said service using a calling card (column 2, lines 42-53). Therefore, it would have been obvious to allow users to pay for the services of Reese using the calling card of

Stimson et al.. However, Stimson et al. do not explicitly recite calling cards that store money. Walker et al. teach a calling card account that stores monetary value (column 4, lines 36-43). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Stimson et al., Reese, and Walker in order to allow customers to pay for multiple services (e.g. telephone calls and gaming) using a single card.

As per claims 25 and 26, it is well known to associate a new card number with the transaction history and registration data of the consumer, for example if a card is lost by consumer.

As per claim 28, warning a credit card or other type of card with value that a card owner lacks sufficient funds to cover the cost of a charge is old and well-known.

As per claims 27, 29, and 30, claim 20 is directed to a settlement system comprising a settlement terminal device, one or more authentication devices and a settlement management device. Therefore, limitations directed to a media is non-functional as it does not alter the way the system performs to achieve the utility of the invention and does not distinguish Applicant's system from the prior art. Further, the Examiner takes Official Notice that it is well known to distribute cards via a slip or where the media is supplied on separable sheets.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Fonseca discloses calling cards distributed on separate-able sheets
- D'Urso et al. disclose telephone services

* Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

(703) 872-9306 (for formal communications intended for entry and after-final communications),

or:

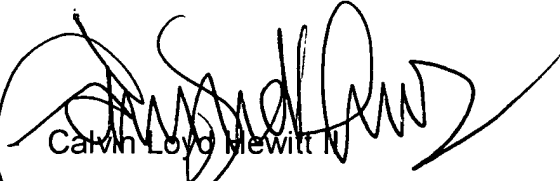
Application/Control Number: 09/857,043

Page 9

Art Unit: 3621

(571) 273-6709 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")


Calvin Lloyd Hewitt II
DATE